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REMARKS

Claims 26-37, 40-42 and 44 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner has determined that the phrase "adapted for storage" in claim 26 is confusing and that the clause "may be" in claim 26 is too open-ended and is unclear as to what is being claimed. Applicant hereby amends claim 26 to remove the phrase "adapted for storage" and to remove the clause "may be." These changes are made to better describe the claimed invention by removing confusing language, not for the purpose of patentability. Reconsideration and withdrawal of the rejection is requested.

Claims 26-37, 40-42 and 44 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Examiner states that these claims are rejected because claim 26 contains new matter. Specifically, to overcome this rejection, the Examiner requests that specification support be shown for the phrase "adapted for storage" in claim 26.

The preamble of claim 26 includes "A composition adapted for storage in a form of solid particles..." Applicant claims a composition that comprises, *inter alia*, one or more dipercarboxylic acids that are soluble in water at sterilant concentrations and that are stable when stored as a solid. The specification states that the present invention provides a stable, solid peracid material having an extended shelf life. (Specification, p. 3, ln. 28 – p. 4, ln. 1). The specification states, "As dry solid particles, the dipercarboxylic acids can be stored for extended periods without degradation. It is preferred that the dry solid dipercarboxylic acids be stored in the absence of other organic compounds that could be oxidized by the acids." (Specification, p. 7, ln. 3-7). "The stability of peracids improves by avoiding impurities and also by adding stabilizers, preferably inorganic salts." (Specification, p. 7, ln. 28-29).

As may be seen from the above, there is support for the phrase "adapted for storage" in claim

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26. However, because Applicant has already amended claim 26 to remove the phrase "adapted for storage," *supra*, reconsideration and withdrawal of the rejection is requested.

Claims 26-37, 40-42 and 44 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,503,765 (Schepers, *et al.*) and U.S. Patent No. 5,268,003 (Coope, *et al.*).

Schepers discloses a non-aqueous liquid composition of dipercarboxylic acids that have low solubility in the non-aqueous liquid. The dipercarboxylic acids disclosed by Schepers are mono- or di-percarboxylic amido or imido acids. (Schepers, col. 8, ln. 43-45). These compounds are high molecular weight compounds and Schepers does not disclose their solubility in water. However, because of their high molecular weight, these compounds disclosed by Schepers would not be considered to be soluble in water at concentrations high enough to form a sterilizing solution. This is confirmed by Coope, the other reference cited by the Examiner. (Coope, col. 5, ln., 46-50).

Applicant claims, *inter alia*, dipercarboxylic acids that may be stored as a solid at room temperature and that are soluble in water to form an aqueous solution having a concentration of at least 0.1 wt %. (claim 26). The 0.1 wt % concentration is a concentration that is high enough to form a sterilizing solution.

Schepers does not disclose, teach, suggest or motivate that the high molecular weight peracid compounds that are discussed therein may be dissolved in water at a concentration of at least 0.1 wt %. Schepers discloses solubility of various compounds in non-aqueous solutions, but not in aqueous solutions as claimed by Applicant. (Schepers, col. 12 – col. 14). Schepers discloses peroxyacid concentrations of between 0.1 to 10%, but these concentrations are not in an aqueous solution, but are in the non-aqueous liquid composition of the Schepers invention. (Schepers, col. 4, ln. 30-31). Therefore, Schepers does not teach, suggest or motivate that there exists dipercarboxylic acids that are a stable solid and that can be solubilized in water to form a sterilizing solution as claimed by Applicant.

To establish a *prima facie* case of non-obviousness, there must be (1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one having

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ordinary skill in the art, to modify or to combine reference teachings; (2) a reasonable expectation of success; and (3) all the limitations of the claimed invention disclosed. See MPEP, § 2143.

Schepers does not teach, suggest, motivate or disclose that a dipercarboxylic acid may be stored as a solid and then solubilized in water to form a sterilizing solution having a concentration of at least 0.1 %. In fact, the acids disclosed by Schepers are all high molecular weight acids that are not soluble in water at high enough concentrations to achieve a 0.1 % concentration as claimed by Applicant. Therefore, Schepers does not present *a prima facie* case of obviousness against Applicant's claimed invention. Reconsideration and withdrawal of the rejection is respectfully requested.

Coope discloses the same high molecular weight acid types as Schepers. Coope specifically states that the acids disclosed therein are not soluble in water. Coope states, "When in liquid form, the surfactants serve not only to clean but importantly function as a structuring system to suspend the water-insoluble amido peroxyacids in water or any other solvent carrier." (Coope, col. 5, ln., 46-50). Since the acids disclosed by Coope are not water soluble, Coope does not disclose, teach or suggest a dipercarboxylic acid that is soluble in water at concentrations sufficient to form a sterilizing solution as claimed by Applicant. (claim 26).

Because neither Coope nor Schepers disclose, teach, or suggest a dipercarboxylic acid that is soluble in water at sterilizing concentrations, a *prima facie* case of obviousness has not been presented. Indeed, both Coope and Schepers disclose high molecular weight acids that are not soluble in water, as stated by Coope. Reconsideration and withdrawal of the rejection is respectfully requested.

Please note that Applicant has amended claim 26 to remove the phrase "without an equilibrium amount of hydrogen peroxide." This phrase had been added in the previous Response to describe the claimed invention as having a sterilizing solution formed from a solid, not a liquid dipercarboxylic acid. Since a liquid dipercarboxylic acid always has an equilibrium amount of hydrogen peroxide mixed with it, the limitation "without an equilibrium amount of hydrogen

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"peroxide" was added to exclude liquid dipercarboxylic acids since only solid acids were intended to be claimed. However, because claim 26 contains the limitation that the sterilizing solution is made from a solid dipercarboxylic acid, the further limitation of "without an equilibrium amount of hydrogen peroxide" is redundant and unnecessary to adequately describe the claimed invention. Because this limitation was added in the last Response merely for clarification and not for patentability, its removal should not necessitate additional search. Entry of this amendment is respectfully requested.

In conclusion, Applicant submits that all remaining claims in the present application are entitled to allowance and such action is earnestly solicited. In the event there are additional charges in connection with the filing of this Response, the Commissioner is hereby authorized to charge the Deposit Account No. 50-0714/LYNN/0120.A of the firm of the below-signed attorney in the amount of any necessary fee.

Respectfully submitted,



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